

REMARKS

Applicants first wish to thank the Examiner for her time and consideration involved in examining the application, and specifically this Supplemental Amendment.

Applicants wish to point out an error contained in the Amendment filed on July 20, 2006 in response to the official action of April 20, 2006. In the official action, the Examiner rejected claims 1-8 under § 103(a) based on U.S. Pat. App. Pub. 2004/0050345 to Bauer (“Bauer”) and further in view of U.S. Pat. App. Pub. 2003/0200742 to Smaling (“Smaling”). Applicants responded to this rejection by stating the subject application (i.e., U.S. Serial No. 10/692,840), Bauer, and Smaling were, at the time the invention of the subject patent application was made, owned by ArvinMeritor, Inc. This is partially incorrect because the invention disclosed in the subject application is jointly owned by ArvinMeritor, Inc. and the Massachusetts Institute of Technology (MIT). However, Applicants still believe that Bauer and Smaling are disqualified from being considered § 102(e) prior art under § 103(a) in regard to the subject application because, along with the invention of the subject application, **they are still deemed to have been owned by the same entity** under 35 U.S.C. § 103(c)(2), and thus are disqualified under § 103(c)(1).

A joint research agreement was executed on August 17, 2001 between ArvinMeritor, Inc. and MIT and also executed before the date the invention of the subject application was made. Under 35 U.S.C. § 103(c)(2), subject matter developed by another person qualifying as prior art under § 102(e) and a claimed invention shall be deemed to have been owned by the same person for purposes of § 103(c)(1) if:

- (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;
- (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

The invention of the subject application was made on behalf of ArvinMeritor, Inc. and MIT, who are parties to a joint research agreement as previously discussed. The invention claimed in the subject application was made as a result of activities undertaken within the scope of the joint research agreement. The application has been amended to disclose the names of ArvinMeritor, Inc. and MIT as parties to the joint agreement. The amendment is included herewith.

Applicants believe that the requirements to disqualify the references under § 103(c)(2)(A), (B), and (C) have been now been fulfilled. The required statement under 37 C.F.R. § 1.104(c)(4)(iii) is being filed herewith. Therefore, Applicants respectfully believe they have fulfilled their obligations to disqualify Bauer and Smaling under § 103(c) from being used as § 102(e) prior art under § 103(a) against claims 1-8. As such, the Examiner should withdraw her rejections of claims 1-8.

CONCLUSION

In view of the foregoing remarks, it is submitted that this application is in condition for allowance. Action to that end is hereby solicited.

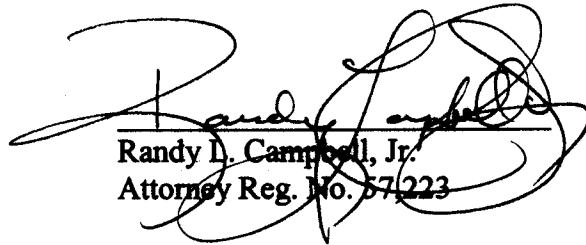
It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response and

shortages in other fees be charged, or any overpayment in fees be credited, to the Account of
Barnes & Thornburg LLP, Deposit Account No. 10-0435 with reference to file 9501-70665.

Respectfully submitted,

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